

REMARKS

The following remarks are responsive to the points raised in the June 2, 2004 non-final Office Action. Claims 14 and 12-26 are pending. Claims 23-26 have been withdrawn from further consideration as being drawn to a non-elected invention. No new matter has been introduced. Entry and reconsideration are respectfully requested.

Response to Election/Restriction

The Examiner requires election of one of the following two distinct inventions:

Group I - Claims 14, and 17-23, drawn to a vibration type driving apparatus, classified in Class 310, Subclass 323.08; or

Group II - Claims 24-26, drawn to a resin composition, classified in Class 252, Subclass 511.

The Examiner urges that Groups I and II are related as mutually exclusive species in an intermediate-final product relationship. The inventions are distinct, per the Examiner, on the basis that the invention of Group II is believed to be useful as a resin composition in products other than a vibration type driving apparatus, such as a sensor or printed circuit board, and that there is nothing in the record to show them to be obvious variants.

In the event Group I is elected, the Examiner requires election to one of the two distinct species:

Species A, directed to specific compositions of a resin composition, Claims 18-21; or

Species B, directed to a mesophase pitch based carbon fiber exhibiting optically anisotropy, which when heated changes from a liquid phase to a solid phase, Claim 23.

The Examiner has not identified Claim 22 as belonging with either of Species A or B.

In addition to electing a single invention and a single species, in the event Group I is elected, Applicants are also required to provide a listing of all of the Claims readable on the elected species.

Applicants respectfully submit that Group I (Claims 14, and 17-23) and Group II (Claims 24-26), as well as Species A (Claims 18-21) and Species B (Claim 23), are properly presented in the same application and that no serious burden on the Examiner exists. The Examiner has not provided sufficient evidence or line of reasoning to show that the identified Groups and/or Species are distinct and pose any serious burden thereon to preclude examination in the same application. As such, the Examiner has not satisfied the two criteria identified in Section 803 of the MPEP. Notwithstanding any actual independence or distinction between the identified Groups and Species, Section 803 of the MPEP requires examiners to search and examine application containing independent or distinct invention when no serious burden exists. Section 803 of the MPEP also states that:

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

The Examiner has not provided any specific discussion, line of reasoning, and/or evidence to support his conclusion that a serious burden, in fact, exists.

In view of the above discussion, it is respectfully submitted that the restriction to one of the identified groups and conditional election of species requirement are improper

Response

and should be withdrawn. Accordingly, action on the merits for both Groups I and II, including Species A and B, is respectfully requested.

Notwithstanding the restriction and conditional election requirements, the Examiner, in the second paragraph of Item 6 on Page 4 of the June 2, 2004 non-final Office Action, has identified Group I, Species A, as an originally presented invention of which Applicants have constructively elected by virtue of its original presentation for prosecution on the merits. On this basis, the Examiner has withdrawn Claims 23-26 from consideration as being directed to a non-elected invention.

In the interest of fulfilling the restriction and election requirements as presented by the Examiner, Applicants hereby elect Group I, Species A, which species is readable on Claims 14, and 17-22 in which Claim 14 is generic to both Species A and B of Group I, i.e., Claim 14 is generic to Species A (Claims 18-22) and Species B (Claim 23).

Response to the Rejections under 35 U.S.C. § 103(a)

Claims 14, 17, 19, and 22 have been rejected under 35 U.S.C. § 103(a) as being obvious over US Patent 5,150,000 to Imasaka et al. (Imasaka) in view of US Patent 5,068,052 to Watanabe et al. (Watanabe). Claims 18, 20, and 21 have been rejected under 35 U.S.C. § 103(a) as being obvious over Imasaka in view of Watanabe, as applied to Claim 14, and further in view of US Patent 5,380,805 to Tamai et al. (Tamai).

Applicants respectfully traverses these rejections.

The Examiner admits that the primary teaching of Imasaka does not teach each feature of the claimed invention and therefore attempts to relay on the secondary teaching

of Watanabe to remedy the deficiency of Imasaka. Specifically, the Examiner, in the fifth and sixth paragraphs on Page 5 of the non-final Office Action, states that:

“Imasaka does not appear to mention that the pitch based carbon fiber is in a ‘mesophase’ state such that it can be called a ‘mesophase pitch based carbon fiber’

Watanabe teaches that allowing carbon fibers to be in a mesophase pitch based state with a degree of liquid crystalline properties (see Claims 4 and 5), has the advantages of providing a resin composition with suitable molding properties (see col. 4, lines 44-48).”

From here, the Examiner concludes, in the seventh paragraph on Page 5 of the non-final Office Action, that:

“It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the carbon fibers of Imasaka by forming the carbon fibers in a ‘mesophase pitch based’ state, as taught by Watanabe, to positively provide a resin composition with suitable molding properties.”

Imasaka discloses an ultrasonic motor including a stator, a rotor, and a friction material. The friction material of Imasaka being firmly attached to the rotor so as to act as a contact surface between the stator and the rotor. Imasaka discloses a plurality of compositions from which the friction material has been fabricated and subsequently tested on the basis of each composition’s ability to (1) absorb vibration to prevent the production of noise, (2) provide a smooth slipping between the rotor and the stator to produce a stable driving force, (3) resist heat to reduce wear of the contact surfaces to maintain long term performance, and (4) provide a lower hardness with respect to the metallic stator to maintain eliminate stator damage and to provide a constant holding torque between the stator and rotor when the motor is at rest. As the Examiner has

Response

correctly pointed out, a resin composition containing mesophase pitch based carbon fiber is not a composition disclosed by Imasaka.

The secondary teaching of Watanabe discloses a resin composition containing smectic liquid crystal that effectively improves the thermal deformation temperature and impact strength. Watanabe also discloses, as pointed out by the Examiner, that the properties of the disclosed resin composition are suitable for injection molding and extrusion of films, sheets, and fibers, etc. A review of Watanabe reveals that Watanabe provides no teaching relating to ultrasonic motors, or related elements, that support the conclusion of obviousness advanced by the Examiner.

The Examiner has not pointed out any specific teaching or suggestion in the prior art references of Imasaka and Watanabe, or other specific line of reasoning, that would motivate of ordinary skill in the art, at the time the present invention was made, to modify the ultrasonic motor of Imasaka by forming the carbon fibers thereof as taught by Watanabe. The Examiner has not established that there is a reasonable expectation that the presented modification of Imasaka in view of Watanabe would be successful. As set forth, in part, in Section 2142 of the Manual of Patent Examining Procedure:

“[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.”

In view of the above discussion, independent Claim 14 is distinguished over the primary and secondary prior art references of Imasaka and Watanabe, either alone or in combination. Rejected dependent Claims 17, 19, and 22 are also distinguished over Imasaka and Watanabe, either alone or in combination, for at least the same reasons as independent Claim 14. Furthermore, dependent Claims 18, 20, 21, and 23 (Claim 23

Response

being withdrawn from consideration by the Examiner as not being drawing to the originally presented invention, i.e., Group I, Species B) are likewise distinguished over Imasaka and Watanabe, either alone or on combination, for at least the same reasons as independent Claim 14. Accordingly, the rejection under 35 U.S.C. § 103(a) over Imasaka in view of Watanabe should be withdrawn.

For at least the same reasons as discussed above with respect to independent Claim 14, dependent Claims 18, 20, and 21 are not taught or suggested by Imasaka, Watanabe, and Tamai, either alone or in combination. Notwithstanding the dependency of Claims 18, 20, and 21 upon independent Claim 14, the combined teachings of Imasaka and Watanabe, as advanced by the Examiner, are deficient in that their combined teaching does not include the specific resin compositions recited by Claims 18, 20, and 21. To remedy such deficiencies, the Examiner attempts to rely on the tertiary teaching of Tamai.

A review of Tamai reveals that Tamai provides no teaching relating to ultrasonic motors, or related elements, that support the conclusion of obviousness advanced by the Examiner. The Examiner has not pointed out any specific teaching or suggestion in the prior art references of Imasaka, Watanabe, and Tamai, or other specific line of reasoning, that would motivate of ordinary skill in the art, at the time the present invention was made, to further modify the ultrasonic motor of Imasaka, already modified in view of Watanabe, to arrive at the invention recited in dependent Claims 18, 20, and 21. As such, dependent Claims 18, 20, and 21 are further distinguished over the prior art teachings of Imasaka, Watanabe, and Tamai, either alone or in combination. Likewise, dependent Claim 23 is distinguished over the prior art teachings of Imasaka, Watanabe, and Tamai,

either alone or in combination. Accordingly, the rejection under 35 U.S.C. § 103(a) over Imasaka in view of Watanabe and in further view of Tamai should be withdrawn.

CONCLUSION

Applicant respectfully submits that Claims 14 and 17-23 are in condition for allowance and a notice to that effect is earnestly solicited.

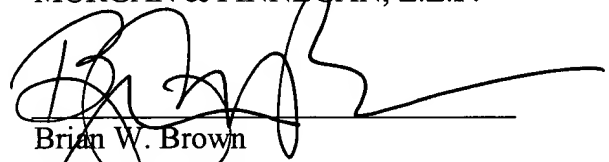
AUTHORIZATIONS:

The Commissioner is hereby authorized to charge any additional fees which may be required for the timely consideration of this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 1231-4475US1.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Date: September 1, 2004

By:



Brian W. Brown

Reg. No.: 47,265

(202) 857-7887 Telephone

(202) 857-7929 Facsimile

Correspondence Address:

Morgan & Finnegan
3 World Financial Center
New York, NY 10281-2101
(212) 415-8700 Telephone
(212) 415-8701 Facsimile